

REMARKS/DISCUSSION OF ISSUES

Claims 1-3 are pending in the application. Claims 1-3 are rejected.

Acceptance of the drawings filed on 13 November 2001 is noted with appreciation.

Claims 1-3 are rejected under 35 USC 251 as being an improper recapture of broadened claimed subject matter surrendered during prosecution of the original application 09/891,611 (sic), issued as patent 5,986,400, upon which this reissue application is based.

Specifically, the limitation 'active layer made from a semiconducting conjugated soluble polymer' of claim 3 of this reissue application is said to be broader than cancelled claims 4 and 5 of the original application 09/891,611 (sic), and also broader than claim 1 of the original patent 5,986,400.

More specifically, the limitation 'active layer made from a semiconducting conjugated polymer selected from poly (3-alkylthiophene) and poly (p-phenylene vinylene) polymers', in combination with other elements of the device, is said to define claim 1 of the patent patentably over the prior art, so that the narrow scope of the claims of the patent was not an error within the meaning of Section 251, and the broader scope surrendered in the application cannot be recaptured here.

However, the limitation 'active layer made from a semiconducting conjugated polymer selected from poly (3-alkylthiophene) and poly (p-phenylene vinylene) polymers' was not added to claim 1 of the original patent (claim 13 of the original application) in order to define patentable subject matter over any prior art. Rather, as pointed out in the remarks accompanying the amendment which inserted the

limitation on December 21, 1998, it was stated that the limitation was added to 'more clearly define the invention'.

In the Office action of 15 March 1999 following the above-described amendment of claim 13, rather than applying any prior art in response to the amendment, the Examiner instead dropped the prior rejection of claim 13 under Section 103, and rejected the claims for double patenting over prior patent 5,705,888. This rejection was subsequently overcome by the filing a terminal disclaimer.

Moreover, claims 4 and 5 of the original application 08/891,611 were not cancelled in view of any prior art, but were cancelled because they had already been allowed in parent application 08/523,837, and issued in patent 5,705,888.

In summary, neither the amendment of claim 13 nor the cancellation of claims 4 and 5 in the original application was made for or necessitated by the prior art. Accordingly, claim 3 of this reissue application is not an attempt to recapture subject matter previously given up in order to define patentable subject matter, but rather is an attempt to claim subject matter which Applicant is entitled to claim but failed to claim previously through error. This is exactly the kind of situation which a reissue patent with broadened claims is designed to remedy.

Accordingly, it is urged that the rejection of claims 1-3 under 35 USC 251 as an improper recapture of previously surrendered subject matter is in error and should be withdrawn.

Claims 1-3 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5 of parent patent 5,705,888.

Claim 1 claims an active layer selected from the group consisting of poly (3-alkylthiophene) and poly (p-phenylene vinylene) (the latter referred to as 'PPV').

Claims 4 and 5 of parent patent '888 each claim an active layer which is a PPV derivative (see col. 3, lines 18 and 25-33). However, neither claims 4 and 5 nor any other of the '888 claims call for an active layer comprising poly (3-alkylthiophene) (the first member of the group of claim 1) or any of its derivatives.

Moreover, claiming two specific PPV derivatives would not suggest to the skilled artisan that it would be possible to claim PPV generally.

Thus, claims 1 and 2 are not obvious over claims 1-5 of the parent patent '888.

Claim 3 calls for the semiconducting conjugated polymer to be soluble, and does not call for insulating areas in the first electrode layer.

In contrast, claims 1-5 of parent patent '888 call for patterned insulating areas in the first electrode layer, and do not call for the semiconducting conjugated polymer to be soluble.

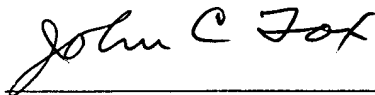
Thus, claims 1-5 of parent patent '888 would not suggest to the skilled artisan the combination of elements claimed in claim 3.

Thus, claim 3 is not obvious over claims 1-5 of the '888 parent patent.

In summary, claims 1-3 are not obvious over claims 1-5 of the '888 parent patent, and it is urged that the double patenting rejection is in error and should be withdrawn.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of record, allow all the pending claims, and find the application to be in condition for allowance.

Respectfully submitted,

A handwritten signature in cursive script that reads "John C. Fox".

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203-329-6584